

REMARKS:

With entry of this amendment, claims 1, 3, 4, and 18-34 are pending. Claims 1, 3, and 4 stand rejected, and claims 18-32 have been newly added. Claims 2 and 5 have been previously cancelled, and claims 6-16 have been cancelled by this amendment.

Based on the foregoing amendments and following remarks, reconsideration of this application is respectfully requested.

Claim Rejections-35 U.S.C. §102

Claims 1, 3, and 4 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,531,788 to Dibie et al. ("Dibie"). Applicants respectfully traverse the rejections of claims 1, 3, and 4, since Dibie does not disclose each and every element of the claims. As an initial matter, Applicants note that claim amendments were not made to overcome any current or future rejections, based on prior art or otherwise, but rather to better clarify the claimed invention.

The claimed invention requires a "helical vasoocclusion coil," which in accordance with the interpretation that one of ordinary skill in the art would reach, refers to a "coil of a coil" configuration, i.e., a primary coil configuration that is further formed into a secondary coil or helical configuration. For example, the Declaration of Michael Wallace, attached hereto as Exhibit A, provides evidence that the ordinary and accustomed meaning of the term "helical vasoocclusion coil" refers to a device that has a primary coil configuration that is wrapped into a secondary helical configuration. This declaration further provides evidence that one of ordinary skill in the art would consider the claimed "windings" to refer to the windings of the secondary helical configuration.

The background of the specification also makes clear that the term “helical vasoocclusion coil” refers to “coil in a coil” configuration, and that the windings of the helical vasoocclusion coil refer to the windings of the secondary helical or coil configuration. The specification provides, “[O]ne type of vasoocclusion device is in the form of a helical wire coil,” and then cites U.S. Patent No. 4,994,069 as an example of a helical wire coil. (page 1, lines 11-12). Although Applicants are aware that U.S. Patent No. 4,994,069 has not been expressly incorporated by reference in the specification, and thus, its disclosure cannot be used to provide written description for the claims, this patent can be used as a tool to determine how one of ordinary skill in the art would construe the claims. See In re Cortwright, 165 F.3d 1353, 1359 (Fed. Cir. 1999).

U.S. Patent No. 4,994,069 provides:

The steps in the construction of vaso-occlusion wire 14 are illustrated in FIGS. 2A-2C. The wire itself is formed by wrappings or windings of a fine wire thread 18, preferably 0.002 mils to 0.006 mils platinum, tungsten, or gold thread which is available, for example, from California Fine Wire Company (Grover City, Calif.). The windings are preferably made by wrapping the thread on a spinning mandrel, according to known coil-manufacturing methods. The wire advance on the mandrel is adjusted to produce a single-layer coil with a minimum helical pitch, i.e., in which the windings are close packed.

* * *

The coiled wire is wound on a larger-diameter mandrel to form a helical winding 20 whose helix diameter, indicated at 22, is approximately that of the vessel for which the coil is intended. The helical axis is indicated at 23. (col. 4, line 45 to col. 5, line 1).

Turning now to the prior art rejection, the Dible device discloses a filtering device that is formed of a simple primary coil with no secondary coil or helical configuration, and that the windings of the Dible filtering device are the windings of the simple primary coil. Thus, because Dible does not disclose a “coil in a coil” configuration, Applicants submit that independent claims 1 and 4, as well as dependent claim 3, are not anticipated by Dible, and as such, respectfully request withdrawal of the §102 rejections of these claims.

New Claims

Claims 18-32, which Applicants submit are supported by the specification, as originally filed, and are patentable over the cited prior art, have been newly added. In particular, all of these claims require the “coil in a coil” configuration. As previously stated, Dible does not disclose this configuration. In addition, there is no suggestion to modify the Dible device into a “coil in a coil” configuration. Significantly, the Dible device must be capable of deforming the vena cava by flattening it heightwise (col. 7, lines 56-62), whereas a “coil in a coil” configuration is a soft compliant structure that tends to conform to the vessel or cavity in which it is disposed.

Conclusion

Based on the foregoing, all claims pending in the application are believed to be allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this amendment, the Examiner is respectfully requested to contact the undersigned at (714) 830-0600.

7013072001
PATENT

Respectfully submitted,

Bingham McCutchen LLP

Dated: December 9, 2003

By: 

Michael J. Bolan
Reg. No. 42,339

Bingham McCutchen LLP
Three Embarcadero Center
San Francisco, California 94111